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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

ASI0001-US

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Typed or printed name _____

Application Number

09/598,239

Filed

June 21, 2000

First Named Inventor

Norman D. GEDDES

Art Unit

3623

Examiner

Irshadullah, M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

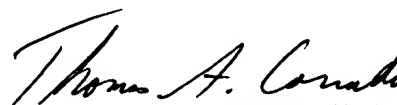
The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 44,657 / 42,439☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

 Michael J. Dimino

Typed or printed name

202 508 5800

Telephone number

September 12, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Application of:

Norman D. GEDDES

Application Number: 09/598,239

Filed: 06/21/2000

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Art Unit: 3623

Examiner: M. IRSHADULLAH

For: Method and System for Intelligent Supply Chain Collaboration

USPTO Customer Service Window, Attn: Mail Stop AF
Randolph Building
401 Dulany Street
Alexandria, VA 22314

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Office Action mailed 06/10/2005 (the "Final OA") and the Office Action of 07/20/04 (the "Second OA"), and concurrent with a Notice of Appeal, the undersigned respectfully requests a Pre-Appeal Brief Review of the rejections of record in light of the following remarks.

REMARKS

The Office Actions repeatedly mischaracterize the references to find claim elements not present in the references. In several instances, quotes from the references have been altered to include claim limitations: Claims 1, 11, 17, 20, and 23 (*determines one or more goals, a management system that collects and distributes data regarding one or more business processes*), see Reply of 01/19/2005 ("Second Reply") page 5, and Remarks herein directed to one of the more egregious alterations of a reference; Claims 2 and 21 (*knowledge base includes one or more plan goal graphs*), See Second Reply page 13; Claims 3, 7, and 22 (*concept graphs*), see Second Reply page 13; Claims 6 and 7 (*manage life cycle states of ... plan instances according to a commitment level of the partial order planner*), see Second Reply page 15; Claim 9 (*scripts comprising a sequence of fully or partially specified actions*), see Second Reply page 6; Claims 20 (*using a nonmonotonic truth maintenance system for determining a goal*), see

Second Reply page 18; Claims 23 and 25 (*plurality of intelligent agents*); see Second Reply page 11; and Claim 26 (*detect conflicts between one or more users*), see Second Reply page 12.

The OAs refuse to consider some claim limitations: Claim 4 (*inference engine creates one or more plan instances*), see Second Reply page 14; Claim 8 (*where the inference engine determines further processing*), see Second Reply page 16.

The OAs ignore explicit definitions provided in the written description for some claim terms: Claims 10 and 25 (*intent interpreter*), see Second Reply page 7; and Claims 16, 18, and 19 (*partial order planner, least commitment planner*), see Second Reply page 8.

The OAs summarily reject claims as not directed to statutory subject matter citing a test without practical basis in the constitution, statute, case law, or authorized regulation. See Second Reply page 3, and further Remarks herein.

The OAs summarily reject claims on the basis of judicially-created double patenting without the appropriate analysis – a mere *pro forma* statement summarily rejecting the claims is all that is presented. See further Remarks herein.

Further remarks are directed to assertions first made in the Final OA.

Regarding “a management system that collects and distributes data” as found in Claims 1, 11, 17, 20, and 23.

The Second OA asserts that AMADO, in disclosing a menu system that allows importing and exporting of data, anticipates the claimed limitation of a *management system that collects and distributes data*. When challenged in the Second Reply that AMADO’s disclosure does not amount to the claimed limitation, the FINAL OA asserts:

... Microsoft’s Computer Dictionary, Third Edition, page 246, ... defines “import” as “To bring or receive or collect information or data from one system or program into another” and on page 185 “Export” as “To move or transmit or communicate or distribute information or data from one system or program to another”. In light of the definition, Amado’s <disclosure of a menu system that allows “importing” and “exporting” anticipates a *management system that collects and distributes*>

Disturbingly, the Microsoft Computer dictionary states no such thing. The undersigned has checked the 3rd, 4th, and 5th editions of the Microsoft Computer Dictionary for the definition of “import” and “export.” Each edition defines “export” as follows, and defines “import”

similarly; in each case **never using the words “collect” or “distributed” as stated by the Examiner.**

export vb. To move information from one system or program to another. Files that consist of only text can be exported in ASCII (plain text format). For files with graphics however, the receiving system or program must offer some support for the exported file's format. See also EPS, PICT, TIFF. Compare import.

Regarding “a management system that ... determines one or more goals” as found in Claims 1, 11, 17, 20, and 23.

The Second Reply argued that (1) the Second OA misquoted AMADO as disclosing “finding or determining unit goals,” and (2) having predefined goals is the antithesis of determining a goal. In response, the FINAL OA noted that “it is irrelevant whether <the goals> are predefined or not.” See FINAL OA, page 20. It is not apparent how it can be irrelevant that a reference states the antithesis of an explicit claim limitation.

Regarding “comprise a sequence of fully or partially specified actions” as found in Claim 9.

The Second Reply argued that (1) the Second OA **again misquoted** AMADO, this time as disclosing “scripts” and such scripts having “action instructions or sequence of fully or partially specified actions,” and (2) AMADO’s actual disclosure relates to scripts used to define behavior of application interface and link screen elements to application objects, not as portions of the knowledge base (as claimed). See Second Reply, page 6.

In response to the Second OA assertion that AMADO, disclosing a menu system that “can be used for (1) Auditing daily operations at companies with pre-defined measurable goals ...”, the Second Reply notes that **determining** a goal is substantially different from using a **pre-defined** goal.

Regarding “intent interpreter” as found in Claims 10 and 25.

The undersigned respectfully notes that where the written description provides an explicit definition for a term, as in this case for *intent interpreter*, that explicit definition controls.

Regarding Claims 17-22 as rejected under 35 U.S.C. §101 as non-statutory subject matter.

The Second OA asserted a two pronged test for statutory subject matter that includes “whether the invention is within the technological arts” as the first prong. In response to the undersigned’s request that a valid constitutional, statutory, case law, or regulatory basis be identified for this prong, the Third OA cites *In re Musgrave*, 167 U.S.P.Q. 280 (CCCPA 1970), *In re Johnston*, 183 USPQ 172 (CCPA 1974), *Ex Parte Bowman*, 61 USPQ2d 1669, 1671 (BPAI 2001 (unpublished), MPEP §2106 IV 2(b)¹, and *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1374-75, 47 USPQ 2d at 1602.

Bowman is distinguished from the present application since Bowman “carefully avoided tying the disclosed and claimed invention to any technological art or environment. The invention disclosed and claimed in the present invention is closely tied to computer systems and computer implemented method throughout. Further, Bowman provide no direction whatsoever with regard to the meaning of “technological arts.”

The only bit of law related to “technological arts” cited by in Johnston is:

FN12 "The phrase 'technological arts' * * * is synonymous with the phrase 'useful arts' as it appears in Article I, Section 8 of the Constitution." In re Waldbaum, 59 CCPA 940, 457 F.2d 997, 173 USPQ 430 (1972).

The only bit of law related to “technological arts” cited in Musgrave is:

[FN 5] ... All that is necessary, in our view, to make a sequence of operational steps a statutory "process" within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance *290 with the Constitutional purpose to promote the progress of "useful arts." Const. Art. 1, sec. 8.

So “technological arts” equals “useful arts” with no definition provided for either. The current rejection amounts to a summary rejection not supported by statute, case law, or authorized regulation. Finally, while invoking MPEP §2106 IV B.2(b), the record shows no evaluation of the claims under that section.

As noted in the Second Reply, the applicable test derives from *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998); i.e., the claimed invention is required to produce a useful,

¹ It appears that the reference should have been to MPEP §2106 B.2(b).

concrete, and tangible result. Specifically, the *plan* in Claim 17, and claims dependent thereon, is a useful, concrete, and tangible result.

Either the rejections under §101 as non-statutory subject matter should be withdrawn since the claims do produce a useful, concrete, and tangible result, or an appropriate test should be applied in a non-summary fashion to reject the claims.

Regarding Claims 1-26 as rejected under judicially-created doctrine of obviousness-type double patenting.

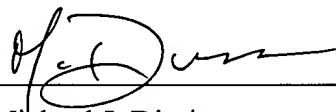
While a terminal disclaimer may be appropriate where identical claims are found in an issued patent and a pending application, other claims acknowledged to have features not found in the Applicant's '192 patent are summarily rejected with unsupported variations of the phrase ... the <undisclosed> feature is old and well known in the AI art. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the feature in the application, thereby providing a system enabling the users to <accomplish some purpose of the Applicant's invention>. Either these rejections should be withdrawn, or analysis and support should be provided for the rejections.

CONCLUSION

The foregoing is submitted as a *bond fide* effort to advance prosecution of the application by requesting review of clear errors in the rejections and of omission of essential elements needed for a *prima facie* rejection. With consideration of the above amendment and remarks, the undersigned submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution might be advanced by discussing the application with the undersigned, in person or over the telephone, we would welcome the opportunity to do so. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-1458, and please credit any excess fees to such deposit account.

Respectfully submitted,

Date: September 17, 2005
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By: 
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